

REMARKS

Summary

Claims 1-6, 12-20, 24, 26-29, 31-38, 41-46, and 48-71 are pending. In this response, claim 25 is cancelled, claims 1, 24, 26-27, and 59-61 are amended, and claims 62-71 are added. No new matter has been introduced.

Rejection of Claims 24, 33, 35, 50, and 52

Claims 24, 33, 35, 50, and 52 are rejected under 35 USC 102(e) as being unpatentable over US Patent No. 6,874,023 to Pennell (Pennell). Applicant respectfully traverses the rejection in light of the amendments to the claims and the remarks below.

Claim 24 has been amended to incorporate the subject matter of claim 25 (now cancelled) and to specify the notification feature. Claim 24 provides for the electronic device notifying the email service provider of employment of the first or second email address prior to initiation of a communication with the user by the communication partner or group of partners. Pennell provides no such teaching or suggestion. In Pennell, the service simply facilitates the use of various email addresses, not the notification of employment of an address. In addition, US Patent No. 6,725,269 to Megiddo (Megiddo) fails to overcome the deficiencies of Pennell (Megiddo was cited in combination with Pennell against claim 25, now incorporated into claim 24). Megiddo provides a teaching of identity selection and access of various email boxes, but provides no teaching or suggestion of a notification feature as recited in claim 24.

Claim 33 provides for the email service provider organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses.

Pennell provides a mechanism to sort incoming emails by sender, but fails to provide a teaching or suggestion of organizing the emails by whether or not the received email was from an intended or an unintended communication partner of

Best Available Co.

that particular email address as recited in claim 33. Claim 33 provides a mechanism to sort emails based on whether the user intended to communicate with that sender, and thus allows the user to determine whether the provided email address has been, for example, shared with or sold to an unauthorized third party. Again, Pennell simply provides a way to sort incoming emails based on the identity of the sender, not the additional characteristic of whether the sender was an intended or unintended partner.

Claims 35, 50, and 52 contain language similar to that discussed above with respect to claim 33. As claim 33 is patentable over Pennell, so are claims 35, 50, and 52 for at least the reasons discussed above with respect to claim 33.

Claims 26, 27, 34, 36-38, 51, and 53-55 are dependent on claims 24, 33, 35, and 52 incorporating their recitations respectively. Therefore, for at least the same reasons, claims 26, 27, 34, 36-38, 51, and 53-55 are patentable over Pennell.

Rejection of Claims 1-6, 12-16, 24-29, 31-35, 41-52, and 56-61

Claims 1-6, 12-16, 24-29, 31-35, 41-52, and 56-61 are rejected under 35 USC 103(a) as being unpatentable over Pennell, in view of US Patent No. 6,725,269 to Megiddo (Megiddo). Applicant respectfully traverses the rejection in light of the remarks below.

Claim 1 recites, in part, that the first and second email addresses were simultaneously provided to the user computer by the email service provider. Neither Pennell nor Megiddo provides any teaching or suggestion of such a simultaneous provision of addresses.

As admitted in the Office Action, Pennell fails to provide a teaching or suggestion of the provision of a first and a second email address simultaneously. Megiddo teaches the use of various identities which may have associated therewith one or more email addresses. However, Megiddo provides no teaching or suggestion of the provision of a first and a second email address to a user computer simultaneously. Rather, both Pennell and Megiddo discuss the selection of an email address from a list or identity established with the service, which must occur sometime after the email address has been first provided to the user. Thus, the

provision of a first email address simultaneously with the provision of a second email address, as recited in claim 1, is not taught nor suggested by Pennell or Megiddo, alone or in combination.

Claims 28, 45, and 56 contain language similar to that discussed above with respect to claim 1. As claim 1 is patentable over Pennell and Megiddo, so are claims 28, 45, and 56 for at least the same reasons discussed above with respect to claim 1.

Claim 41 provides, in part, for an apparatus to obtain a first and second email address from an email service provider in real time for a user, at the first and second email addresses' respective initial selection for usage. As discussed above, both Pennell and Megiddo discuss the selection of an email address from a list or identity established with the service, which must occur sometime after the email address has been first provided to the user. Alternatively, claim 41 recites the provision of the addresses in real time at the respective selection of an address for usage. Thus, Pennell and Megiddo fail to teach or suggest at least one element of claim 41, and therefore, claim 41 is patentable over Pennell and Megiddo, alone or in combination.

Claim 59 contains language similar to that discussed above with respect to claim 41. As claim 41 is patentable over Pennell and Megiddo, so is claim 59 for at least the reasons discussed above with respect to claim 41.

Claims 24, 33, 35, 50, and 52 are listed in the claims identified with this rejection but are not separately addressed in the Office Action in connection with this rejection. These claims were addressed with respect to the 35 USC 102(e) rejection. The claims have been distinguished from the references above.

Claims 2-6, 12-16, 20, 26-27, 29, 31-32, 34, 42-44, 46, 48-49, 51, 57-58, and 60-61 are dependent on claims 1, 24, 28, 33, 35, 41, 45, 50, 52, 56, and 59 incorporating their recitations respectively. Therefore, for at least the same reasons, claims 2-6, 12-16, 20, 26-27, 29, 31-32, 34, 42-44, 46, 48-49, 51, 57-58, and 60-61 are patentable over Pennell.

Best Available Copy

Rejection of Claims 17-19, 36-38, and 53-55

Claims 17-19, 36-38, and 53-55 are rejected under 35 USC 103(a) as being unpatentable over Pennell, in view of Megiddo, and further in view of US Patent No. 5,923,845 to Kamiya. Applicant respectfully traverses the rejection in light of the remarks below.

Claims 17-19, 36-38, and 53-55 are dependent on claims 1, 35, and 52 incorporating their recitations respectively. Claims 1, 35, and 52 are patentable over Pennell and Megiddo as discussed above. Kamiya fails to overcome the deficiencies of Pennell and Megiddo. Therefore, for at least the same reasons, claims 17-19, 36-38, and 53-55 are patentable over Pennell, Megiddo and Kamiya.

Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1-6, 12-20, 24, 26-29, 31-38, 41-46, and 48-71 are in condition for allowance, and early issuance of the Notice of Allowance is respectfully requested.

If the Examiner has any questions, the Examiner is invited to contact the undersigned at (503) 796-2844. Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,

SCHWABE, WILLIAMSON & WYATT, P.C.

Date: January 5, 2006



Steven Prewitt
Reg. No. 45,023

Schwabe, Williamson & Wyatt, P.C.
Pacwest Center, Stes. 1600-1900
1211 SW Fifth Avenue
Portland, OR 97204-3795
Telephone 503.222.9981

Best Available Copy